

REMARKS

Upon entry of the amendments in this paper, claims 1-11, 22-32, 39 and 40 are pending in the application, with claims 12-32 being withdrawn. Claims 1-11 and 36-38 stand rejected. Claims 1 and 2 are herein amended and claims 39 and 40 are herein added. Claims 12-21 and 36-38 are herein canceled. No new matter is entered. It is respectfully submitted that this paper is fully responsive to the Office action mailed on December 14, 2009.

Claim Rejections – 35 U.S.C. §112

Claims 1-11 and 36-38 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Applicants have amended claims 1 and 2 and canceled claim 36. As such applicant respectfully submits that the claims are in proper form and asks the examiner to withdraw the rejection.

On the Merits

Claim Rejections - 35 U.S.C. §103(a)

Claims 1-5, 8-11 and 36-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,613,191 A1 to *Hylton et al.* in view of U.S. Patent No. 6,226,618 B2 to *Downs et al.*

Independent Claim 1:

Independent claim 1 recites:

A method for transmitting decryption codes for freely transmitted encrypted program contents and for automatically establishing billing data for the program contents, comprising:

a customer receiving encrypted program content from a broadcast source;

connecting the customer to a service provider via the customer's subscriber network, by placing a telephone call;

determining a network terminating unit of the existing connection to the service provider, and a calling party number of the customer and a called number of the service provider;

transmitting a decryption code for a program content to the customer;

establishing billing data using the network terminating unit, in particular the calling party number, the called number of the service provider, and information about the requested program content;

wherein said program content data is transmitted through a different medium than said decryption code and wherein said decryption code is transmitted through a telephone line.

The claimed invention relates to a specific method for transmitting decryption codes combining on the one hand receipt of broadcast information, i.e., information which is transmitted via a unidirectional communication channel and obtaining a decryption code for such a broadcast information via a telephone call, which constitutes a bidirectional communication channel. This important feature is not disclosed in the cited references, either when viewed individually, or together.

The examiner uses a similar rationale as used in the office action dated March 5, 2009. However, regarding the last feature of claim 1, the examiner acknowledges that it is not disclosed or rendered obvious in *Hylton*, but instead contends that it is disclosed in *Downs*. Specifically, the examiner points to FIG. 6 of *Downs* and the associated text.

Hylton US 5,613,191

When discussing the inventive merit of the claimed invention as claimed in independent claim 1 over *Hylton*, the Examiner provides different citations from the *Hylton* reference, which are supposed to show certain features of claim 1.

In this respect it should be pointed out to the Examiner, that even though *Hylton* indeed shows several features of current claim 1, these are not always described with respect to the same embodiment¹ and thus, despite the fact that they are in the same document, a skilled person would not necessarily combine these features to arrive at the feature combination of claim 1, as will be explained in more detail below.

¹ “Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements “arranged as in the claim.”” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). (Emphasis added.) Thus, the features must be described in the same embodiment, or else a reason to combine the separate embodiments must be provided.

The Examiner correctly points out, that *Hylton* discloses receiving program content from a broadcast source, as described in combination with the embodiment of Fig. 3. The broadcast source uses a Hybrid Fiber Coax to transmit the program content to subscribers. As pointed out in column 21, lines 44 - 49, this broadcast information may be encrypted. Also, the system described with respect to Fig. 3 of *Hylton* does not use a uni-directional communication channel for broadcasting the program content but appears to use a bidirectional channel as becomes clear from C.22 I. 20-37.

With respect to the next feature, i.e. connecting the customer to a service provider via the customer's subscriber network, by placing a telephone call, the Examiner refers to C. 16, lines 6-35 and C. 17, lines 28-32 of *Hylton*.

These citations, however, clearly relate to establishing a broadband communication session through a network between **interactive** information service providers 1400 and a subscriber. Such providers 1400 are also mentioned in column 15, line 61 as **non-broadcast service providers** (emphasis added). Therefore, the citations with respect to establishing a broadband connection by placing a telephone call all apply to establishing **non-broadcast sessions** (emphasis added) and not to a broadcast environment. Establishing a bi-directional broadband communication session is something completely different to receiving broadcast information on one hand via a uni-directional channel and then obtaining encryption codes via a bi-directional channel.

The Examiner has failed to provide any reason or motivation why a skilled person would combine features related to a telephone call which is made to start a bidirectional communication session according to Fig. 2 of *Hylton* with features for receiving broadcast information via the hybrid fiber coax described with respect to the embodiment of Fig. 3 of *Hylton*.

The same argument also applies with respect to the feature of “determining a network terminating unit of the existing connection and a calling party number of the customer and a called number of the service provider”, which features are described with respect to the embodiment, wherein a broadband communication session is initiated with a non-broadcast service provider.

Regarding the feature “transmitting a decryption code for a program content to the customer” the Examiner then again jumps back to the embodiment related to Fig. 3, which may broadcast encrypted program content. Such a transmission of a decryption code is not described with respect to the bi-directional broadband session described with respect to Fig. 2 and indeed does not appear to be required for such a bi-directional session as no encrypted content is broadcasted. There is actually no need for encryption in such a bi-directional session.

Similarly, the telephone call for setting up the bi-directional broadband session is not required for obtaining authorization to receive certain broadcast content and for obtaining decryption codes.

With respect to the feature “establishing billing data using a network terminating unit...” the Examiner then again jumps to the embodiment related to initiating the broadband communication session with a non-broadcast provider.

The Examiner in trying to show certain features of claim 1 in the *Hylton* reference freely jumps between the different embodiments of the *Hylton* reference without showing why a skilled person would combine these different features. Indeed when looking at the bi-directional communication session described with respect to Fig. 2 it would not make sense to the skilled person to start ‘broadcasting encrypted program content.’ It should be pointed out that the embodiments according to Fig. 2 and 3 appear to be of a completely different nature and thus, despite the fact that all features are included in a single document, there has to be shown some motivation why the skilled person would indeed combine features of these different embodiments.²

In the official communication the Examiner acknowledges, that *Hylton* does not disclose the feature ‘wherein said program content data is transmitted through a different medium than

said decryption code". This is an important feature of the claimed invention, and is discussed below.

The term "different medium" is supposed to actually indicate the different channels, i.e. a broadcast channel (uni-directional) on which the encrypted program content is transmitted and the telephone line (i.e. bi-directional channel) on which the decryption code is transmitted upon a corresponding request by the customer. This refers to the logical layer indicating uni-directional channels on one hand and bi-directional channels on the other.

With respect to this feature the Examiner had summarily argued that it is known from the *Downs et al.* reference. Applicants respectfully disagree with the examiner, as discussed below.

Downs et al. US 6,226,618

Downs is directed at an electronic content delivery system, with FIG. 6 specifically showing "an overview of the Content Distribution and Licensing Control as it applies to the License Control Layer of FIG. 5." (Column 4, lines 8-10.) Unfortunately, the examiner does not offer any further insight into how he believes the claimed feature is disclosed by FIG. 6. Applicants ask the examiner to please be as specific as possible in pointing out where he believes the claimed feature is disclosed, so that applicants may more precisely respond to the office action, thereby expediting prosecution of the application.

² Net MoneyIN.

The *Downs et al.* reference refers to a method and an apparatus for securely providing electronic content to a user's system. In so doing *Downs et al.* uses multiple communications between a user device and different entities before the content is actually downloaded to the user device. These communications always use bi-directional point-to-point transmissions via the internet.

There is no indication in *Downs et al.* that any broadcast information is provided to the user's device on a unidirectional channel. When looking at the *Downs et al.* reference it is noted that it relates to a very specific and convoluted system, which would actually not even be suitable for receiving any broadcast information. As understood from *Downs et al.* the user first has to get a transaction receipt from an electronic digital content store. Thereafter it has to have this transaction receipt checked by a clearing house, which then provides the customer with a decryption code and a license receipt. Thereafter, the customer has to contact a content hosting site which checks the license receipt and finally transmits the content to the customer. The content is then decrypted by the user device using the decryption code provided by the clearing house.

This convoluted system is clearly not compatible with any broadcast system as claimed in current claim 1, and therefore, there would be no motivation for a skilled person to take any

isolated features from the *Downs et al.* reference such as receiving a decryption code from the clearing house and thus a different entity than the entity transmitting the broadcast information. In this respect it should be stressed that for both these transmissions the same media is used *i.e.*, bi-directional point-to-point transmissions via the internet.

Thus, even if the skilled person would look at *Hylton* and *Downs et al.* he/she could not arrive at the subject matter of the claimed invention as neither reference uses different media to transmit a decryption codes on one hand and broadcast encrypted program content on the other.

Furthermore, it should be noted that the skilled person has no motivation whatsoever to use any random feature from the *Downs et al.* reference in combination with random features taken from different embodiments from the *Hylton* reference.

Independent Claim 39:

Applicants have added independent claim 39 which includes the feature of:

wherein said program content data is transmitted through a different medium than said decryption code, wherein said broadcast source is a line-connected transmission source and wherein said decryption code is transmitted through a telephone line.

The examiner contends that the feature of transmitting a decryption code through a telephone line is disclosed in columns 5, 6, 21 and 22 of *Hylton*. For example, in column 22, lines 34-37 *Hylton* recites:

If the decryption key is needed, the Level 1 Gateway 411 actually instructs the video manager 417 to instruct the VAM 331 to transmit the key to subscriber's DET 100a.

The above passage appears to discuss FIG. 3 of *Hylton*. As shown in FIG. 3, fiber 305 and optical fiber 307 go to the ONU (optical network unit) 309 which then is connected to individual homes.

However, the combination of *Hylton* and *Downs* does not disclose separating the program data from the decryption code using a line connected broadcast source and a telephone line, respectively.

Independent Claim 40:

Applicants have added independent claim 40 which includes the feature of:

wherein said program content data is transmitted through a different medium than said decryption code, wherein said broadcast source is an over-the-air broadcast source and wherein said decryption code is transmitted through a telephone line.

The examiner contends the feature of over-the-air broadcast is disclosed in *Hylton* in column 10 and FIGS. 5 and 6, by a transponder 408 broadcasting to transponders 416 and 418. As shown in FIG. 5, the transponders 416 and 418 are connected to DET (digital entertainment terminal) 100, which is connected to TV 100'.

However, as mentioned above, the combination of *Hylton* and *Downs* does not appear to disclose a method such that program data and a decryption code are transmitted via different mediums. In FIGS. 5 and 6 of *Hylton*, it does not appear to show any decryption code being transmitted through a telephone line.

In view of the above, the Examiner should finally realize the inventive nature of the present application and should grant a patent on the basis of any amended claims you intend to file.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

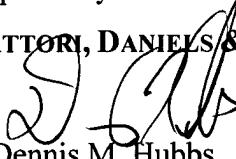
Application No. 10/563,230
Art Unit: 3621

Amendment under 37 C.F.R. §1.116
Attorney Docket No. 053512

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



Dennis M. Hubbs

Attorney for Applicants
Registration No. 59,145
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

DMH/rer